

REMARKS

Claim 1 have been amended to narrow the scope of the content of the water/water-soluble substance to be greater than 85% by weight and the contents of lipids, emulsifiers and lipophilic constituents to be less than 15% by weight. Support for the amendments can be found, for example, on page 5, lines 15-19; page 7, lines 26-29 and the examples.

Claims 1, 3-5, 7-9 and 11 would be pending should the amendment be allowed.

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants wish to address the showing required under 37 CFR § 1.116(a) regarding why the amendments above are necessary and were not presented earlier. According to MPEP 714.13 (Amendments After Final Rejection or Action, Procedure Followed - Action by Examiner), there are four grounds (cited as (A)-(D)) upon which the examiner may elect not to enter the applicants amendment. Each ground is addressed below:

(A) The claims as amended represent a narrower embodiment of the applicants originally claimed invention (applicants reserve the right to pursue broader scope of the original claims in continuing application) and as such it is believed that the amended claims are now in condition for allowance or at the very least simplifies the issues for appeal.

(B) It is believed that no new matter has been entered.

(C) The amended claims represent a narrower embodiment of the applicants invention as claimed prior to the issuance of the examiner's final rejection and as such no new issues are raised which require further consideration or search.

(D) The amendment does not present any additional claims.

In view of the foregoing, Applicants respectfully request that the Examiner enter and consider the amendments above.

35 U.S.C. 112, second paragraph rejection

The rejection of claim 1 was maintained by the examiner for the reasons set forth in the final rejection. It appears that the examiner acknowledges that each of the terms recited have definite meaning but further writes:

"Given the incredible number of polyglycols and amine, it is impossible for one of ordinary skill in the art to be apprised of the 'products' encompassed by this phrase."

This appears to be more a concern about the breadth of scope of the claim rather than the clarity of the claim. However, MPEP 2173.04 states that "Breadth of a claim is not to be equated with indefiniteness" (see also *in re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)).

35 U.S.C. 103(a) rejections

Claims 1-5, 7-9 and 11 remained rejected by the examiner over Diec et al. (WO 98/17232 – listed as Schreiber et al. in office action) in view of Dupuis et al. (U.S. Patent 6,338,858) and Yoneyama et al. (U.S. Patent 5,105,469).

It is noted that the claims as amended have a water phase of greater than 85% which serves as an additional difference between the Schreiber et al. reference and the applicants' claimed invention. Neither the Dupuis or the Yoneyama et al. reference remedy this additional limitation.

However, regardless of whether the present amendment is entered or not, the Dupuis et al. and Yoneyama et al. references are being relied upon by the examiner for isolated teachings which do not consider the respective invention as a whole (i.e. each element relied upon was from a water-in-oil emulsion which utilized different ingredients that those claimed by the applicants). As such, although the compositions could generically be referred to as cosmetic compositions, there is no predictability or suggestion that one could "pick and choose" selected elements out of Dupuis et al. and Yoneyama et al. and substitute them into Schreiber et al.

It has been held that "...**Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.**" see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d 546, 48 USPQ2d 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994)

The examiner appears to argue that the selected elements could be substituted or could be viewed as equivalents. However, MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990). Neither the Dupuis et al. or Yoneyama et al. suggests substitution of the selected element of their invention into a composition such as that described by Schreiber et al. Conversely, Schreiber et al. does not teach or suggest the inclusion of the elements ascribed to Dupuis et al. or Yoneyama et al.

Closing

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (7 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 14 March 2003

By: Vilma I. Fernandez

Vilma I. Fernandez